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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/440,557 | 11/15/1999 | RANDOLPH B. LIPSCHER | 1039-0010 | 3106 |

34456 7590 03/30/2005

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EXAMINER

MORGAN, ROBERT W

ART UNIT PAPER NUMBER

3626

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/440,557

Applicant(s)

LIPSCHER ET AL.

Examiner

Robert W. Morgan

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-7,9,11-13,25-29,33-46,64,65,73,77 and 79-92 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-7,9,11-13,25-29,33-46,64,65,73,77 and 79-92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. In the amendment filed on 12/28/04 the following has occurred: Claim 10 has been canceled. Now claims 2-7, 9, 11-13, 25-29, 33-46, 64-65, 73, 77 and 79-92 are presented for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2-5, 7, 9, 25-29, 33-44, 64-65, 73, 77, 91 and 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,385,592 to Angles et al. and U.S. Patent No. 6,018,713 to Coli et al. in view of U.S. Patent No. 5,845,255 to Mayaud, for the same reasons given in the previous Office Action (dated 9/28/04). Further reasons appear below.

4. Claims 6, 11-13 and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,385,592 to Angles et al. and U.S. Patent No. 6,018,713 to Coli et al. and U.S. Patent No. 5,845,255 to Mayaud in view of Official Notice, for the same reasons given in the previous Office Action (dated 9/28/04). Further reasons appear below.

5. Claims 86 and 90 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,845,255 to Mayaud and U.S. Patent No. 6,385,592 to Angles et al., for the same reasons given in the previous Office Action (dated 9/28/04). Further reasons appear below.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 79-85 and 86-89 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent No. 5,845,255 to Mayaud, for the same reasons given in the previous Office Action (dated 9/28/04). Further reasons appear below.

Response to Arguments

8. Applicant's arguments filed 12/28/04 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 12/28/04.

(A) At pages 11-14 of the 12/28/04 response, Applicant argues that Mayaud fails to teach or suggest in response to the computer user selecting the displayed pharmaceutical advertisement, a prescription form is automatically populated, since Mayaud definition of a list of formulary drugs is not a pharmaceutical advertisement.

In response, it is respectfully submitted that reference of Coli et al. is relied on for teaching a network-based system and method for ordering and cumulative results reporting of medical test at a hospital or physician office that includes **advertising for a particular drug treatment** (reads on "pharmaceutical advertisement") or medical device that may be needed by the patient as part of the test results reporting output (see: column 4, lines 25-35 and abstract). In addition, Coli et al. teaches a client computer programmed to **display advertising and product**

Art Unit: 3626

information after receiving a request from the user's computer (reads on "in response to the computer user selecting the displayed advertisement") (see: column 7, lines 25-47). The Mayaud reference is relied on for teaching a electronic prescription creation system where a list of formulary drugs may be displayed to the physician and if the physician is satisfied with the formulary drugs offered by the prescription management system any one formulary drug may be selected and automatically posted to the prescription (reads on "a prescription form is automatically populated") (see: column 35, lines 38-43 and column 36, lines 26-30). Therefore, the Examiner agrees with the cited definition of the term "advertisement" in the Cambridge Dictionary of American English. However, as mentioned above the Coli et al. reference is relied on for teaching a display of a pharmaceutical advertisement and not Mayaud description of "a list of formulary drugs".

As such, it is respectfully submitted that the rejection given in the prior Office Action dated 9/28/04 is indeed proper and should be maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 3626

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

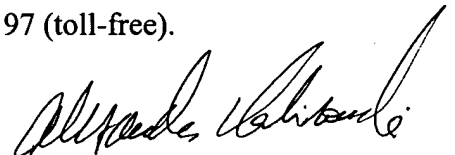
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Morgan whose telephone number is (703) 605-4441.

The examiner can normally be reached on 8:30 a.m. - 5:00 p.m. Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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ALEXANDER KALINOWSKI
PRIMARY EXAMINER